

in all of its respects and further requests reconsideration and withdrawal of the requirement for restriction.

Without prejudice to the foregoing traverse and without prejudice to Applicant's right to petition against the restriction requirement, in compliance with the requirement set forth in the official action, Applicant provisionally elects the claims of Group 1, namely claims 1-5 and 13-19, which the Examiner has characterized as being directed to apparatus

## II. STATEMENT OF FACTS

On September 18, 1998, Applicant filed the above-captioned patent application for a low pressure dryer. In a first office action, denoted as paper number 9 and dated February 8, 2000 the examiner required restriction of the claims to one of two Groups, either Group 1 directed to apparatus claims 1-5 and 13-19, or Group 2 directed to method claims 6-12.

Applicant is an individual inventor, and is a small entity within the meaning of the applicable law.

## III. ARGUMENT

Restriction is authorized under 35 U.S.C. 121 and 37 C.F.R. 1.141(a) and is proper only if "two or more independent and distinct inventions are claimed in one application."<sup>1</sup> Restriction

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<sup>1</sup> The Commissioner interprets this requirement as authorizing restriction if the inventions are independent or distinct.

by the Commissioner is permissible regarding a patent application; restriction is never required of the Commissioner.<sup>2</sup>

Restriction is discretionary with the examiner and must be evaluated on a case-by-case basis. The two basic reasons for requiring division of allegedly independent and "distinct" inventions joined in a single application are: The governmental interest in obtaining proper<sup>3</sup> revenue from filing and issue fees for each application; and, the interest in maintaining the integrity of the classification system for examining applications. Ex parte Yale, 1869 C.T. 110 (Comm'r.Pat. 1869). These governmental interests must be weighed against the standards set forth in the applicable law, regulations and policies, as well as against Applicant's interests, in order to ensure a just result.

**A. The Examiner Has Failed To Meet Her Burden To Show That The Claims Constitute Independent And Distinct Inventions**

The terms "independent" and "distinct" have separate and different meanings. M.P.E.P. 802.01. As used in 35 U.S.C. 121, an "independent" invention means an invention which is not dependent. A process and apparatus used in practicing the process are, by

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<sup>2</sup> "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions..." 35 U.S.C. 121.

<sup>3</sup> As discussed below, "proper revenue" does not mean as much revenue as possible by issuing improper division or restriction requirements; rather, "proper revenue" means just compensation for examining patent application directed to each truly independent and distinct invention.

definition, dependent. M.P.E.P. 802.01. Inventions are distinct if they are both (1) capable of separate manufacture, use, or sale as claimed and (2) patentable over each other. M.P.E.P. 802.01. Assuming two claimed inventions are distinct in this sense, then restriction will in fact be required if, but only if, one or more of the following are present: (1) separate classifications, (2) separate status in the art, and (3) different fields of search. M.P.E.P. §808.02. Every requirement to restrict has two aspects: The reason(s) why the inventions as claimed are either independent or distinct; and, the reason(s) for insisting upon restriction therebetween." M.P.E.P. 808. This two-prong analysis was adopted by the Patent Office in 1975. See Notice of April 9, 1975, 934 O.G. 450.

In the immediate case, the Examiner has classified the claims of Group I as "drawn to a low pressure dryer, classified in class 34, subclass 92" and the claims of Group II as "drawn to a method of continuous supplying and drying of granular material, classified in Class 222, subclass 160." Paper 9, Paragraph 1. However, a mere showing of a separate Patent and Trademark Office classification for the respective inventions in question is not conclusive on the issue of division. Application of Young, 173 F.2d 239, 81 USPQ 139.

Having classified the claims into two different statutory categories, the Examiner then applied M.P.E.P. § 806.05(e) to determine that the claims of Group I and Group II constitute distinct inventions. M.P.E.P. § 806.05(e) provides that

In applications claiming inventions in different statutory categories, only one-way distinctness is generally needed to support a restriction requirement.

Process and apparatus for its practice can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process as *claimed* can be practiced by another materially different apparatus or by hand, or (2) the apparatus as *claimed* can be used to practice another and materially different process. (emphasis in original).

The Examiner has reasoned that "[I]n this case, the process as claimed can be practiced by another materially different apparatus or by hand, because the independently claimed method with the step of 'supplying granular or powdery material. . . ' [e.g. Claim 9] and the step of 'continually supplying dried granular resin material. . . ' [e.g Claim 7] are not limitations in the independently claimed apparatus. These features distinguish the independently claimed method from the independently claimed apparatus, resulting in independent and distinct inventions." Paper 9, Paragraph 2.

However, M.P.E.P. 806.05(e) explicitly states that "the burden is on the examiner to provide reasonable examples that recite material differences." In this case, the Examiner has provided no examples to document the conclusion that the process as claimed can be performed by a materially different apparatus or by hand, and thus has failed to meet the burden explicitly stated in M.P.E.P. § 806.05(e). The burden now falls on the Examiner to document another materially different process or apparatus, or to withdraw the restriction requirement. M.P.E.P. 806.05(e).

Furthermore, the M.P.E.P. makes it crystal clear that before

restriction can be required, there must be a showing that the inventions, each of which is defined by one or more claims, must be both "independent" and "distinct" from one another. In the instant case, no such showing has been made by the Examiner.

A showing that two inventions are "distinct", as the examiner purports to have made in the Official Action, does not obviate the requirement to also make a showing that the inventions are "independent." The inventions described by Applicant are not independent. To be independent, inventions must have

no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect. M.P.E.P. 802.01. Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. M.P.E.P. 806.04.

Applying the rule of M.P.E.P. 806.04, it is clear that the instant application describes an apparatus and process which are not independent inventions. The apparatus of Claims 1-5 and 13-19 can be used to practice the process described in claims 6-8, and therefore is not an independent invention.

Even if two patent application claims are patentably distinct from one another, this does not ipso facto mean that restriction should be required. There are two criteria which must exist in order that a requirement for restriction be proper as between patentably distinct inventions: first, the inventions must be independent or distinct as claimed; second, there must be a serious burden on the examiner if restriction is not required. M.P.E.P.

803. If the search and examination of the an entire application can be made without serious burden, the examiner must examine the application on its merits, in its entirety, even though the application includes claims to distinct or independent inventions. M.P.E.P. 803.

**B. Practical And Equitable Considerations Mandate Review Of Applicant's Claims As A Single Application**

A close examination of the practical and equitable considerations surrounding the present case compels withdrawal of the examiner's restriction requirement and require inclusion of all the claims presented by Applicant in a single patent application.

**1. Scope Of Search**

The salient consideration for insisting upon restriction and determining the propriety of a restriction requirement is the scope of the examiner's search for prior art. Applicant is entitled to a full and thorough search of the prior art as a consequence of having filed his application and having paid the statutory application fee. 35 U.S.C. 131.

Restriction is proper only where the examiner would be unduly burdened by searching numerous, unrelated inventions or technologies. Thus, the scope of a search for related inventions, even though burdensome, cannot justify restriction of the related inventions. Further, even if an application includes claims to unrelated inventions, i.e., distinct and independent, the examiner

must examine the application on its merits, in its entirety, if the search and examination of the entire patent application can be made without a serious burden on the examiner. M.P.E.P. 803.

The examiner's instructional guidelines for performing such a search for any application are set forth in the M.P.E.P. The guidelines compel the examiner to search in classes and subclasses in which independent and distinct (as defined by the M.P.E.P.) inventions would be classified. For example, section 904.01(c) recites:

"Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts regardless of where classified. The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called. (emphasis added).

Section 904.01(d) recites:

A proper field of search includes the subclass in which the claimed subject matter of an application would be properly classified.

In outlining a field of search the examiner should note every class and subclass under the U.S. Patent Classification system and other organized systems of literature, that may have material pertinent to the subject matter as claimed. Every subclass, digest and cross reference art collection pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

The examiner should plan a search that not only covers the claimed subject matter, but one that also covers the disclosed features that might reasonably be expected to be claimed. (emphasis added).

Section 904.02 recites:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment.

It thus results that the examiner finds references that, while not needed for treating the claims, would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his or her invention, and claimable with the subject matter being currently claimed, but shown to be old by these references. (emphasis added).

From the above-quoted guidelines, it is clear that the scope of a proper search includes:

- (1) Classes and subclasses in which the claimed subject matter is classified;
- (2) Classes and subclasses that may have material pertinent to the claimed subject matter; and
- (3) Classes and subclasses containing subject matter present in the disclosure which might reasonably be expected to be claimed during the prosecution; and,
- (4) Classes and subclasses that may contain subject matter disclose material related to features which might reasonably be expected to be claimed.

Therefore, only where inventions are independent and distinct (as defined by the M.P.E.P.), and require nonoverlapping searches, is restriction proper.



The various disclosed low pressure dryer apparatus and methods of the present invention are interrelated and merit patent protection. They are all directed to a common technology, i.e., plastic resin processing/drying, and stem from the core inventive concepts. Thus, the examiner will not be unduly burdened by searching and examining all of the claims presented by Applicant in a single application. The examiner's search will not be narrowed or reduced by compliance with the restriction requirement, since Applicant has clearly manifested his intent to claim each novel and nonobvious aspect of the invention as evidenced by the claims in the application.

**2. Cost To Applicant of the Proposed Restriction Would Be Unduly Burdensome**

While the Patent and Trademark has a legitimate interest in obtaining proper revenue from filing and issuance fees, it does not have unrestrained power to tax inventors. Applicant is entitled to obtain patent protection on each of the nonobvious invention aspects of the low pressure dryer apparatus and methods which it has disclosed. If the Applicant, an individual inventor, is forced to divide this application into two separate patent applications as suggested by the examiner, Applicant will be unduly and unfairly burdened with excessive fees and costs associated with prosecuting and maintaining 2 patents versus 1 patent.

**a) Government Fees Will Nearly Double**

If Applicant is forced to divide the present application into two separate patent applications as suggested by the examiner, Applicant will pay a minimum of over \$7,970.00 in government fees to apply for, receive and maintain two separate patents, an increase of over \$3,810.00 over the expected fees for a single application. This additional expense places is unreasonably burdensome on an individual inventor for an invention which has yet to be commercialized.

The following Table 1 illustrates the additional fees which would be generated in the event the 2-way restriction requirement for the instant application is maintained and one (1) divisional application is filed:

TABLE 1

A)	Original non-refundable filing fee (including preliminary amendment)	\$ 696.00
B)	Filing fees for 1 additional invention, i.e., Group 2 of claims	\$ 345.00
C)	Issue fees (2 x \$605)	\$1210.00
D)	Maintenance fees	
	i) 3.5 years (2 x \$415)	\$ 830.00
	ii) 7.5 years (2 x \$950)	\$1900.00
	iii) 11.5 years (2 x \$1,455)	\$2910.00
E)	Recording assignment (2 x \$40)	\$ 80.00
TOTAL		\$7971.00

Undoubtedly this will increase in time as the Patent & Trademark Office increases its fees.

**b) Original Filing Fee Will Not Be Refunded**

If Applicant is forced to divide the present application into 2 separate patent applications as suggested by the examiner, Applicant will be unjustly penalized \$351.00 (\$696-\$345) unrefunded application fees. Applicant has already paid a governmental application fee in the amount of \$696.00. If claims to only one Group is elected and prosecuted, the excess application fee paid for the remaining Group, i.e., \$351.00, will not be refunded by the patent office or credited to Applicant towards any related application stemming from the present application. Hence, Applicant will be unjustly penalized an additional \$351.00 if the examiner's restriction requirement is maintained.

**3) The Patent Office's First Responsibility Is Public Service, Not Collecting Revenue**

While Applicant recognizes the Patent & Trademark Office's interest in obtaining proper revenue from filing and issuance fees, the Patent & Trademark Office is not in the business of assisting the IRS in reducing the national debt. The sole function of the Patent & Trademark Office is to serve the public in an efficient and expeditious manner. The Patent & Trademark Office is charged with a duty to carry out its responsibility of examining patent applications in a manner most efficient to the public. Efficient use of administrative resources and expeditious processing of this application will be better served by performing one comprehensive search than performing 2 separate searches.

#### IV. CONCLUSION

For all of the foregoing reasons, Applicant respectfully submits that the restriction requirement currently in the Application is not well-founded and should be withdrawn, with all of the Claims pending in the Application being examined collectively following a single, comprehensive search of the prior art. Notification that the restriction requirement has been reconsidered and withdrawn is respectfully solicited.

Respectfully submitted,



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